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10/573,234	12/06/2006	Richard Jeffrey Jordan	AC00047-006 (26668-117)	7655

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
05/11/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary	Application No.	Applicant(s)	
	10/573,234	JORDAN ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7 and 11-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7 and 11-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 2/15/2011

Election/Restrictions

1. Newly amended claims 8-10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Originally filed claims 1-32 are directed towards providing bonuses to players based on the value of player activity.

Newly amended claims 8-10 are now directed to a system in which players at associated player terminals are randomly selected to receive a bonus, which is actually opposite to the original intent of the claims, that being performance-based awards.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-10 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-4, 6, and 11-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding claims 1-4, 6, and 11-32, based on Supreme Court precedent, a method/process claim must **(1)** be tied to a particular machine or apparatus (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or **(2)** transform a particular article to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Boushy (U.S. Patent No. 5,761,647).** Boushy discloses a system and method of awarding bonuses to users that include all of the limitations recited in the above claims.

Regarding claim 1, Boushy discloses collecting player data at a plurality of sites and compiling the data(Column 2 Line 45 – Colum 3 Line 22) selecting a device and awarding a bonus to the player of the device by generating an indication of the bonus (Column 5 Lines 53-64 and Column 8 Lines 8-25). Boushy discloses player activity for gaming and non-gaming activities, the non-gaming activity data being collected through a POS (Column 8, Line 55 - Column 9 Line 2). A worth of a player (theoretical win) is determined across multiple casino locations (Column 12 Line 18 – Column 13 Line 40). Boushy teaches that players may be awarded based on customer activity and customer worth (Column 12 Line 18 - Column 13 Line 40).

Regarding claims 2 and 3, Boushy discloses a master server and slave servers networked together to compile data (Figures 2A-2C).

Regarding claim 4, devices are selected based on a user playing the device, not based on any kind of pay table (Column 5 Lines 53-64).

Regarding claim 6, Boushy discloses compiling wagering data and POS data on each terminal or POS (Column 5 Lines 53-64 and Column 8, Line 55 - Column 9 Line 2).

Regarding claim 7, Boushy discloses a master server and slave servers networked together to compile wagering data (Figures 2A-2C), and awarding a bonus based on exceeding numerous random thresholds (Column 12 Line 5 - Column 13 Line 5). Boushy discloses player activity for gaming and non-gaming activities, the non-gaming activity data being collected through a POS (Column 8, Line 55 - Column 9 Line 2). A worth of a player (theoretical win) is determined across multiple casino locations

(Column 12 Line 18 – Column 13 Line 40). Boushy teaches that players may be awarded based on customer activity and customer worth (Column 12 Line 18 - Column 13 Line 40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy (U.S. Patent No. 5,761,647).**

Regarding claim 11, Boushy teaches storing past player wagering activity (Column 11 Lines 27-33 and Column 12 Line 55 - Column 13 Line 5), transferring player data to a local cache responsive to local wagering (Column 2 Lines 6-24), tracking current player wagering (Column 5 Lines 53-64), and awarding a bonus responsive to play criteria exclusive of outcome (Column 12 Line 55 - Column 13 Line 5). Boushy discloses player activity for gaming and non-gaming activities, the non-gaming activity data being collected through a POS (Column 8, Line 55 - Column 9 Line 2). A worth of a player (theoretical win) is determined across multiple casino locations (Column 12 Line 18 – Column 13 Line 40). Boushy teaches that players may be awarded based on customer activity and customer worth (Column 12 Line 18 - Column 13 Line 40).

While Boushy discloses various types of gambling, Boushy does not appear to specify pari-mutuel betting. However, Official Notice is taken that pari-mutuel is old and well known. Pari-mutuel betting was said to be first used in 1867, which pre-dates Applicant's invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to award bonuses on pari-mutuel betting. This would attract more users with a larger variety of bonus-ready games.

Regarding claim 12, Boushy discloses play criteria as an amount of wagers over a predetermined time period (Claim 1).

Regarding claims 13-18, Boushy discloses an award redeemable at a number of sites (Abstract), but does not appear to specify bonuses such as free race wagers, free multi-use wagers, electronic drawings, or randomly awarded amounts funded by wagers. However, the type of reward given does not affect the steps taken in the method. In other words, the steps of the method will be performed the same regardless of the type of award. Further, it's well known that offering multiple options of bonuses will encourage a greater number of patrons to use the service in question. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to offer any number of rewards, including those recited in the claim language, to entice a greater number of patrons having differing tastes in rewards to gamble at the casinos of Boushy.

Regarding claims 19-23, 26, and 27, Boushy discloses multiple ways of determining player eligibility. Boushy teaches that tracked players are eligible for the bonus (Column 9 Lines 40-53). Boushy further specifies time periods of eligibility for

wagering and visits (Column 12 Line 5 - Column 13 Line 5). Boushy further teaches a number of winning wagers (Column 12 Line 55 - Column 13 Line 5), as well as the wagering of a certain amount during a specific type of wagering (at the casinos in question) within a specific time frame (Column 12 Line 5 - Column 13 Line 5).

Regarding claims 24 and 25, while Boushy discloses various types of gambling and multiple ways of determining player eligibility, including placing any type of wager, Boushy does not appear to specify pari-mutuel betting such as track betting. However, Official Notice is taken that pari-mutuel and track gambling are old and well known. Pari-mutuel betting was said to be first used in 1867, which pre-dates Applicant's invention. The Kentucky Derby started using pari-mutuel betting for track races in 1908, which also pre-dates Applicant's invention. Daily Double, Exacta, Quinella, Trifecta, and Pick Three are all types of horse racing bets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to award bonuses on pari-mutuel betting. This would attract more users with a larger variety of bonus-ready games.

5. **Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy (U.S. Patent No. 5,761,647) in view of Olsen (U.S. Patent No. 6,210,275).**

Regarding claims 28-30, Boushy discloses storing user betting activity and awarding a bonus to a user based on wagering activity (Column 12 Line 55 - Column 13 Line 5). The bonuses of Boushy are awarded at any time regardless of winning

outcomes, and therefore the bonuses may be given before, after, or at the same time wagers are placed. Boushy discloses player activity for gaming and non-gaming activities, the non-gaming activity data being collected through a POS (Column 8, Line 55 - Column 9 Line 2). A worth of a player (theoretical win) is determined across multiple casino locations (Column 12 Line 18 – Column 13 Line 40). Boushy teaches that players may be awarded based on customer activity and customer worth (Column 12 Line 18 - Column 13 Line 40). Placing a bet is equivalent to "purchasing" an opportunity to win money.

Boushy doesn't appear to specify storing a selected outcome and awarding a payout based on the selected outcome and a future event. Olsen, however, discloses an electronic horse racing game in which players select an outcome (selection in an electronic device would have to be stored and such storage is considered a database) and awarding a payout based on a future event (Column 5 Lines 45-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a gaming apparatus such as that of Olsen, as such an apparatus might be viewed as fun and could attract further patrons.

Regarding claim 31, while Boushy discloses indicating bonuses electronically on a terminal (Column 8 Lines 8-25), Boushy does not appear to specify printing of a ticket listing an awarded bonus. However, Official Notice is taken that printers are old and well known. Hewlett Packard has been developing desktop printers to accompany desktop computers long before the filing of Applicant's invention. it would have been obvious to one having ordinary skill in the art at the time the invention was made to

provide a printer in the terminals and kiosks of Boushy in the interest of allowing a user to print any type of information needed, including bonus information.

Regarding claim 32, Boushy does not appear to specify a bonus being determined by a winning outcome. Olsen, however, discloses playing a "bonus game" to receive a bonus, where the outcome of the bonus game would determine the bonus (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a bonus either based on the outcome of a game, or regardless of an outcome of a game. Casinos might choose either option depending on marketing strategy or future goals and outlook.

Response to Arguments

6. Applicant amended method claims 1, 11, and 28 in the interest of overcoming the 101 rejection. However, the amendments do not overcome the rejection because the step performed by the computer in each claim is considered to be insignificant extra-solution activity. Insignificant steps are considered to be sending, receiving, storing, and displaying. Claims 1 and 28 recite "collecting, via a processor", which is considered to be a step of receiving. Claim 11 recites "transferring, via a processor", which is considered a step of sending. An example of a significant step can be found in claim 1, which recites "determining a worth of a player". Since this step is clearly a significant step or calculation that can't be construed as sending, receiving, storing, or displaying, an amendment reciting the step as performed by a computer would overcome the 101 rejection over that claim.

7. All other arguments are believed to have been addressed by the amended rejections above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Primary Examiner, Art Unit 3622